REMARKS

I. Introduction

In response to the Office Action dated January 24, 2006, the claims have not been amended. Claims 1-21 remain in the application. Re-examination and re-consideration of the application is requested.

II. Prior Art Rejections

On page (2) of the Office Action, claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Goodenough et al., "Queries and Their Application to Reasoning with Remote Sensing and GIS," (Goodenough) in view of Drutman et al., "Marine Geophysics Modeling With Geographic Information Systems," (Drutman), and further in view of Alexander Jr., U.S. Patent No. 6,083,353 (Alexander).

Specifically, claims 1, 8, and 15 were rejected as follows:

> As per claim 1, Goodenough teaches the claimed "method of obtaining a map in a computer graphics program" comprising: "receiving a request for a map picture" (Goodenough, the query to request a map that shows the forest depletion over past 20 years; page 1201, column 2, lines 55-58); "obtaining a map file in response to the request" (Goodenough, a map file comprises the GIS files of the desired site dated 20 years ago, the thematic mapper (TM) and color infra-red geocoded imagery over the site; page 1201, column 2, lines 60-62); "determining, from the map file, a location of map data" (Goodenough, to determine the location of the map data related to the areas representing depleted forest cover; page 1201, column 2, lines 64-66), "wherein the map data defines one or more map objects of the map picture" (Goodenough, the depleted forest cover is the map object of the map picture; page 1201, column 2, lines 64-66); and "obtaining the map data from the location, wherein the obtained map data satisfies the request for the map picture" (Goodenough, the data from the thematic mapper is obtained to satisfy the request for the map showing the forest depletion over paste 20 years; page 1203, column 1, lines 11-12). It is noted that although Goodenough teaches the GIS data in both of raster and vector formats (Abstract, lines 1-3); Goodenough does not explicidy teach that the obtained map data is "vector based" map data. However, Drutman teaches that the feature map information, such as Goodenough's depleted forest data, is preferably represented in vector based format (Drutman, representation of feature/attribute; Table II, page III-529). Furthermore, Alexander teaches that a map file containing vector-based objects defines a specific object on the map can be obtained from the Internet or World Wide Web which communicates through Uniform Resource Locators (URLs) (Alexander, column 1, lines 25-28 and the communication device 26 in figure 3, column 12, lines 29-33 or column 5, lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made, in view of the teaching of Drutman and Alexander, to configure Goodenough's method as claimed by storing the map representing the area's features in a vector format (Drutman, page III-528, column 2, lines 28-30) in a location in memory identifiable by its URLs for communication in World Wide Web (Alexander, connection of the system to Internet, column 12, lines 29-33). The motivation for storing the map representing the objects in a vector format in a location in memory identifiable by its URLs is the simplicity of map file with its vector-based objects communicated through their URLs and the richness of resource provided in the Internet (Alexander, column 5, lines 57-65).

As per claim 8, Goodenough teaches the claimed "apparatus for obtaining a map computer-implemented graphics system" comprising "(a) a computer" (Goodenough, the SEIDAM intelligent system; page 1199, column 1, lines 41-46); "(b) an application executing on the computer" (Goodenough, the problem solver is written in Prolog; page 1203, column 1, lines 32-34), wherein the application is configured to: "receive a request for a map picture" (Goodenough, the query to request a map that shows the forest depletion over past 20 years; page 1201, column 2, lines 55-58); "obtain a map file" (Goodenough, a map file comprises the GIS files of the desired site dated 20 years ago, the thematic mapper (TM) and color infra-red geocoded imagery over the site; page 1201, column 2, lines 60-62); "determine, from the map file, a storage location of map data" (Goodenough, to determine the location of the map data related to the areas representing depleted forest cover; page 1201, column 2, lines 64-66), "wherein the map data defines one or more map objects of the map picture" (Goodenough, the depleted forest cover is the map object of the map picture; page 1201, column 2, lines 64-66); and "obtain the map data from the location, wherein the obtained map data satisfies the request for the map picture" (Goodenough, the data from the thematic mapper is obtained to satisfy the request for the map showing the forest depletion over past 20 years; page 1203, column 1, lines 11-12). It is noted that although Goodenough teaches the GIS data in both of raster and vector formats (Abstract, lines 1-3); Goodenough does not explicitly teach that the obtained map data is "vector based" map data. However, Drutman teaches that the feature map information, such as Goodenough's depleted forest area, is preferably represented in vector based format (Drutman, representation of feature/attribute; Table II, page III-529). Furthermore, Alexander teaches that a map file containing vector-based objects defines a specific object on the map can be obtained from the Internet or World Wide Web which communicates through Uniform Resource Locators (URLs) (Alexander, column 1, lines 25-28 and the communication device 26 in figure 3, column 12, lines 29-33 or column 5, lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made, in view of the teaching of Drutman and Alexander, to configure Goodenough's method as claimed by storing the map representing the area's features in a vector format (Drutman, page III-528, column 2, lines 28-30) in a location in memory identifiable by its URLs for communication in World Wide Web (Alexander, connection of the system to Internet, column 12, lines 29-33). The motivation for storing the map representing the objects in a vector format in a location in memory identifiable by its URLs is the simplicity of map file with its vector-based objects communicated through their URLs and the richness of resource provided in the Internet (Alexander, column 5, lines 57-65).

As per claim 15, Goodenough teaches the claimed "article of manufacture embodying logic that causes a computer-implemented graphics system to obtain a map" comprising: "receiving a request for a map picture" (Goodenough, the query to request a map that shows the forest depletion over past 20 years; page 1201, column 2, lines 55-58); "obtaining a map file" (Goodenough, a map file comprises the GIS files of the desired site dated 20 years ago, the thematic mapper (TM) and color infra-red geocoded imagery over the site; page 1201, column 2, lines 60-62); "determining, from the map file, a storage location of map data" (Goodenough, to determine the location of the map data related to the areas representing depleted forest cover; page 1201, column 2, lines 64-66), "wherein the map data defines one or more map objects of the map picture" (Goodenough, the depleted forest cover is the map object of the map picture; page 1201, column 2, lines 64-66); and "obtaining the map data from the location, wherein the obtained map data satisfies the request for the map picture" (Goodenough, the data from the thematic mapper is obtained to satisfy the request for the map showing the forest depletion over past 20 years; page 1203, column 1, lines 11-12). It is noted that although Goodenough teaches the GIS data in both of raster and vector formats (Abstract, lines 1-3); Goodenough does not explicitly teach that the obtained map data is "vector based" map data. However, Drutman teaches that the feature map information, such as Goodenough's depleted forest area, is preferably represented in vector based format (Drutman, representation of feature/attribute; Table II, page III-529). Furthermore, Alexander teaches that a map file containing vector-based objects defines a specific object on the map can be obtained from the Internet or World Wide Web which communicates through Uniform Resource Locators (URLs) (Alexander, column 1, lines 25-28

> and the communication device 26 in figure 3, column 12, lines 29-33 or column 5, lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made, in view of the teaching of Drutman and Alexander, to configure Goodenough's method as claimed by storing the map representing the area's features in a vector format (Drutman, page III-528, column 2, lines 28-30) in a location in memory identifiable by its URLs for communicating in World Wide Web (Alexander, connection of the system to Internet, column 12, lines 29-33). The motivation for storing the map representing the objects in a vector format in a location in memory identifiable by its URLs is the simplicity of map file with its vector-based objects communicated through their URLs and the richness of resource provided in the Internet (Alexander, column 5, lines 57-65).

Applicant traverses the above rejections for one or more of the following reasons:

(1) Goodenough, Drutman, and Alexander do not teach, disclose or suggest a map file that provides a uniform resource locator;

(2) Goodenough, Drutman, and Alexander do not teach, disclose or suggest a map file that provides a uniform resource locator that identifies a storage location of vector based map data;

(3) Goodenough, Drutman, and Alexander do not teach, disclose or suggest the ability to determine a storage location of vector based map data that defines a map object for a requested map picture;

(4) Goodenough, Drutman, and Alexander do not teach, disclose or suggest obtaining vector based map data from a storage location wherein the vector based map data satisfies a request for a map picture;

(5) There is no motivation to combine the cited references; and

(6) Alexander is not a valid reference with respect to the present invention.

Independent claims 1, 8, and 15 are generally directed to obtaining a vector based map in a graphics program. As claimed, a request is received for a map picture. In response to the request, a map file is obtained. As used in the subsequent claim steps, the map file contains a uniform resource locator (URL) that identifies a storage location of vector based map data. Accordingly, the method determines, from the map file, a storage location, in the form of a URL, of the vector based map data. Further, the vector based map data defines one or more map objects of the map picture that has been requested. Once the storage location has been determined, the vector based map data is obtained from the location at the URL. In this regard, the retrieved/obtained vector based map data satisfies the request for the map picture.

In view of the above, the claims clearly provide that a map picture is requested and a map file that references locations of vector based map data (that defines map objects) for the map picture is obtained/retrieved.

The cited references do not teach nor suggest these various elements of Applicants' independent claims.

In rejecting the claims, the Office Action relies on Goodenough to teach the map file, location of map data, map objects, and the obtaining of map data from the storage location. Under the analysis presented in the Office Action, the location of Goodenough's map data merely refers to a map area that represents depleted forest cover. However, the present claims provide that the location is a storage location for the vector based map data. In other words, the claims clearly provide that the map file does not merely contain the map data/map objects themselves, but instead identifies a storage location of the vector based map data for the map. On the other hand, Goodenough does not even remotely describe a map file that contains a storage location of map data.

In rejecting the map file containing a storage location of vector based map data, the Office Action asserts that the claimed map file is taught by Goodenough's GIS files of the desired site data 20 years ago, the thematic mapper (TM) and color infra-red geocoded imagery over the site. However, as can be clearly seen, GIS files containing desired site data, a thematic mapper and color infra-red geocoded imagery does not even remotely refer to nor suggest a file that contains or identifies a storage location of vector based map data. In this regard, the actual map data itself is noticeably distinguishable from an identifier of where the map data is stored (i.e., the claimed storage location). Applicants assert that there is not even a remote similarity between the two.

The Office Action continues and provides that the determination of an identifier of the storage location is taught by Goodenough's teaching of a location of map data related to the areas representing depleted forest cover. The cited language provides:

> To create the forest depletion map, the TM imagery would have to be processed to detect the areas representing depleted forest cover.

As can be seen, such text does not describe a determination of a storage location of vector based map data (as claimed). Instead, areas from within a map are detected wherein such areas

represent depleted forest cover. Such a teaching does not and cannot teach, disclose, refer to, or suggest the presently claimed determining of a storage location.

The action further continues and provides that the claimed step of obtaining the map data from the same identified storage location is taught by Goodenough's obtaining data from a thematic mapper to satisfy a request for a map showing forest depletion over the past 20 years. There are significant problems with such an assertion. Firstly, if the PTO is asserting that the data is obtained from the thematic mapper, then in accordance with the claims: (1) the thematic mapper must be a storage location; and (2) the file must contain a reference to the thematic mapper. With respect to (1), it is clear in Goodenough that the thematic mapper is not a storage location but instead is a mapper or application. Further, Goodenough alludes to the existence of TM imagery (see page 1201, col. 2, lines 60-67). However, neither an application or imagery itself is a storage location that contains data. With respect to (2), the GIS files of Goodenough actually contain the forest distribution, TM imagery and color infra-red geocoded imagery, as well as image processing and visualization tools (see page 1201, col. 2, lines 60-64). However, Goodenough's files do NOT contain a storage location of the TM imagery. Again, the claims provide that the file identifies a storage location of the vector based map data and does not contain the map data itself. Goodenough's GIS files actually contain the imagery data itself. Accordingly, Goodenough does not and cannot teach the invention as claimed. Further, the claim limitations for which Goodenough is relied upon, are not taught, disclosed, or suggested by Goodenough.

The Office Action further admits that Goodenough fails to teach that the obtained map data is vector based map data. In this regard, Applicants submit that not only do the claims require vector based map data but the claims as a whole must be examined. MPEP 2141.01 provides that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The context of the claims and the invention as a whole utilizes a map file that contains/identifies a storage location of vector based map data that is then retrieved (from the identified storage location) to satisfy a request for a map picture. Accordingly, this "whole" concept and use of the map file and vector based map data cannot be disregarded. The Office Action

attempts to extract vector based map data from one reference and a location of trees that appear in a map to read on the claim language. Such an assertion fails to consider the claim as a whole and whether the claimed invention as a whole would have been obvious in view of the cited references. Further, Applicants note that while Drutman discloses a table comparing vector and raster data formats, the combined context and use of vector based map data (as claimed as a whole) is not even remotely described or alluded to by Drutman or the combination of Drutman with Goodenough.

The Action then continues and relies on Alexander to teach a map file containing a URL that identifies a storage location. Applicants firstly note that the priority date of the present application is October 30, 1996. Alexander was filed on September 5, 1997 and relies on a provisional application filed on Sep. 6, 1996. Thus, while the present application's priority date predates Alexander's filing date, it does not predate the provisional date. However, it is unclear if the provisional application can be used to establish a priority date in the present matter.

To rely on a provisional filing date to beat the date of the present invention, two conditions must be satisfied: (1) the subject matter of the claim in the issued patent must be supported in accordance with 35 U.S.C 112, first paragraph, in the earlier filed application, and (2) the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). (See MPEP 201.11 and MPEP 706.02(f)(1); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978); *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997); and *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002)).

Applicants have been attempting to gain access to the provisional application. In this regard, on February 7, 2006, a message was left for Examiner Nguyen requesting a copy of the provisional application. No return call was received and a copy has not been provided to date. Further, Applicants have been attempting to gain access to the provisional application through an outside service since February 7, 2006. However, the provisional application is not available in IFW, was originally reported as being lost, and is now allegedly with the Group Art Unit. Accordingly, we have been unable to access the provisional to ensure that all of the requirements have been satisfied.

In view of the above, Applicants submit that Alexander does not qualify as prior art with respect to the present invention. Further, it is not Applicant's burden to establish or prove the validity of a priority date. Instead, the Examiner has the burden of establishing a prima facie case of obviousness including the validity of a priority date. Such a prima facie case has not been established.

Accordingly, Applicants respectfully request that a copy of the provisional application be provided to Applicants and further that the Examiner set forth (1) how the claims of Alexander are supported under 35 U.S.C. 112 by the provisional application and (2) where in the provisional, the language of the issued Alexander patent (upon which the Action relies) exists.

Nonetheless, in the interest of expediting prosecution, Applicants address Alexander substantively herein. The Action submits that Alexander teaches a map file containing vector based objects that defines a specific object on a map. Firstly, such an assertion in itself is outside of the scope of the claims. As stated above, the claims provide for a map file that identifies a storage location of vector based map data and not a file containing vector based objects themselves.

The action then asserts that the map file can be obtained from the Internet or WWW via communicating through URLs by col. 1, lines 25-28 and the communication device in figure 3, column 12, lines 29-33 or column 5, lines 57-65. Applicants respectfully traverse such assertions. Col. 1, lines 25-28 provide:

> Electronic maps have recently become available to replace paper maps for some applications. A map database is stored in a memory storage device as a bit map or as vectors that point to a map character.

Col. 12, lines 29-33 provide:

> Another port is used for communication using a Digital Wireless spread spectrum which communicates at distances of up to one mile line-of-sight. The wireless packet radio link uses the tcp/ip protocol for compatibility with sending and receiving data over the Internet. See FIG. 12.

Col. 5, lines 57-65 provide:

> The optional network communication module 8, connected to the CPU 1 by a high speed data link 2, can be utilized to enable the GDM to communicate with remote facilities, for example a home office computer which can receive and send data from and to the GDM. The network communication module 8 can utilize, for example, wireless or wired networks. In a specific embodiment, at least two GDMs can communicate with each other via network communication modules, for example, to transfer data.

As can be seen, the above text does not refer to or disclose a URL. Further, an electronic search of Alexander for the term URL or "uniform" provides no results whatsoever. Without even

disclosing or mentioning the term URL, Alexander cannot possibly be used to teach a specific claim limitation directed towards a URL. In addition, as can be seen, while the above text describes electronic maps and the ability to communicate over a wireless network (also supported by Fig. 3, item 26), such text does not even remotely describe that a map file contains a URL for storage location of vector based map data as claimed. In this regard, the mere ability to communicate over a wireless network does not and cannot teach a file that contains a specific URL for a storage location for particular data as claimed. Thus, the teaching of Alexander is being taken completely out of context and used to assert a teaching that extends far beyond the scope of Alexander.

The action lastly concludes that the motivation to combine all of the references exists because of the simplicity of a map file with vector-based objets communicated through the URLs and the richness of resources provided in the Internet. Applicants appreciate the acknowledgement of the advantages of the present invention. However, such simplicity and advantages are not acknowledged anywhere in the cited references. Under MPEP §2141.01, "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". Such a motivation to combine clearly relies on impermissible hindsight afforded by the present invention and the teaching of the present invention. In this regard, there is no motivation to combine the cited references in the manner set forth in the Office Action.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Goodenough, Drutman, and Alexander. In addition, Applicants' invention solves problems not recognized by Goodenough, Drutman, and Alexander.

Thus, Applicants submit that independent claims 1, 8, and 15 are allowable over Goodenough, Drutman, and Alexander. Further, dependent claims 2-7, 9-14, and 16-21 are submitted to be allowable over Goodenough, Drutman, and Alexander in the same manner, because they are dependent on independent claims 1, 8, and 15, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-7, 9-14, and 16-21 recite additional novel elements not shown by Goodenough, Drutman, and Alexander.

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: April 24, 2006

By: _____
Name: Jason S. Feldmar
Reg. No.: 39,187

JSF/kmk

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